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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/640,369	08/17/2000	Victoria J. Freeman	0065292	5206

7590

08/21/2003

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EXAMINER

ASHBURN, STEVEN L

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 08/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/640,369

Applicant(s)

FREEMAN, VICTORIA J.

Examiner

Steven Ashburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

### ***DETAILED ACTION***

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 20, 2003 has been entered.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkins et al., U.S. Patent 4,756,533 (Jul. 12, 1988) in view of Pritchard, U.S. Patent 1,217,632 (Feb. 27, 1917).

*Hopkins* discloses a lottery game designed for promotional and advertising uses. *See col. 1:55-2:8*. The invention combines both luck and skill to present a particularly challenging lottery game. *See id.* The invention employs multiple jig saw puzzles which each contestant must play simultaneously. *See id.* To increase the challenge of the game, all the jig saw puzzles use identical jig saw patterns, all the boards having identical shaped puzzle pieces in identical positions. *See id.* The puzzle pieces are distributed from a common pool, without indication of which puzzle each piece may solve. *See id.* Each contestant thus is challenged to collect all the required puzzle pieces and, using only the visual clues on the face of each piece, to separate the pieces and then solve the various jig saw puzzles. *See id.* The

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invention encourages on-going contestant participation, making it very useful for promotional activities. Additionally, the invention is readily combined with "instant win" games and sweepstake lotteries to maximize contestant participation. *See id.*

In regards to independent claim 26, *Hopkins* clearly describes all the feature of the claim except having the puzzle pieces being parts of a literary work. Regardless, this feature would have been obvious to an artisan in view of *Pritchard*.

*Pritchard* discloses an analogous puzzle game useful for advertising purposes. *See p. 1:8-25, 1:105-2:2.* In particular, the reference teaches that the puzzle pieces may be parts of a literary work. *See fig. 4, 5; p. 1:35-53, 1:97-104.* *Pritchard* suggests these picture puzzles are beneficial because they are entertaining, instructive and may be varied so as to be as difficult as desired. *See p. 1:105-109.*

In view of *Pritchard*, it would have been obvious to an artisan at the time of the invention to modify the lottery puzzle game disclosed by *Hopkins*, wherein players collect and assemble puzzle pieces to win a prize, to add the feature of having the puzzle pieces being parts of a literary work. As suggested by *Pritchard*, the modification would enhance the puzzle by making the game entertaining, instructive and of variable difficulty. *See p. 1:105-109.*

In regards to dependent claim 27, *Pritchard* additionally suggests that the advertisement may include a corporate name. *See p. 1:109-2:2.*

In regards to dependent claims 28, *Hopkins* additionally teaches that the advertisement may be an ongoing advertising campaign. *See col. 1:34-41, 2:30-35, 3:10-16*

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***Response to Arguments***

Applicant's arguments with respect to claims 26-28 have been considered but are moot in view of the new grounds of rejection.

***Prior Art, Not Relied On***

The following prior art of record is not relied upon but is considered pertinent to applicant's disclosure: U.S. Patents 1,570,906, 3,512,780, 3,964,749, 4,336,664 and 6,336,631 disclose puzzle games used for advertising and promotional purposes.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9302 for regular communications and 703 872 9303 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1078.

S.A.  
August 12, 2003

  
MARK SAGER  
PRIMARY EXAMINER